

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEAN-MARC ASCIONE and MICHAEL DE GEORGE

Appeal 2006-2632
Application 09/881,807
Technology Center 1700

Decided: October 31, 2006

Before OWENS, WALTZ, and GAUDETTE, *Administrative Patent Judges*.
GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Claims 1-168 are pending in this application. Claims 1, 2, 6-57, 61-112, and 116-168 have been finally rejected and are appealed. Claims 3-5, 58-60, and 113-115 have been objected to as dependent upon a rejected base claim. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

BACKGROUND

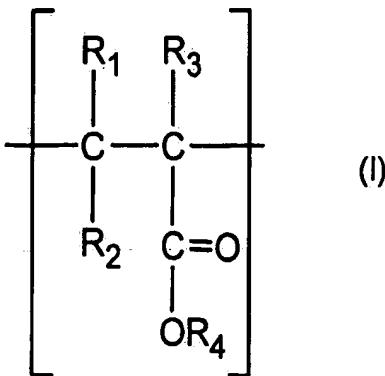
The invention relates to oxidizing compositions for use on keratinous materials, such as hair. The oxidizing compositions are used, for example, for treatments such as dyeing, bleaching, permanent waving, or relaxing/straightening. According to Appellants, in preparing these compositions, it is important to achieve chemical stability of the oxidizing agent and physical stability of the oxidizing composition.

According to Appellants, they have discovered that the use of at least one cationic homopolymer, at least one fatty alcohol, at least one alkoxyolated fatty alcohol, and at least one fatty amide in an oxidizing composition may result in a physically stable composition.

Claim 1 is illustrative of the invention and is reproduced below:

1. A composition comprising:

(a) at least one cationic homopolymer comprising repeating units of formula (I):



Wherein:

-R₁, R₂, and R₃, which may be identical or different, are each chosen from H, alkyl groups, and alkenyl groups; and

R₄ is chosen from groups comprising at least one quaternary amino group;

- (b) at least one fatty alcohol;
- (c) at least one alkoxylated fatty alcohol;
- (d) at least one fatty amide; and
- (e) at least one oxidizing agent.

The Examiner relies on the following prior art references to show unpatentability:

Cotteret	US 5,735,908	Apr. 7, 1998
Casperson	US 6,156,076	Dec. 5, 2000
Narasimhan	US 6,315,989	Nov. 13, 2001

The rejections as presented by the Examiner are as follows:

1. Claims 1, 2, 6-31, 40-48, 52-57, 61-86, 95-103, 107-112, 116-141, 150-158, and 162-168 are rejected under 35 U.S.C. § 103(a) as unpatentable over Narasimhan in view of Cotteret.
2. Claims 32-39, 49-51, 87-94, 104-106, 142-149, and 159-161 are rejected under 35 U.S.C. § 103(a) as unpatentable over Narasimhan in view of Cotteret and further in view of Casperson.

We reverse as to both grounds of rejection.

OPINION

Rejection of Claims 1, 2, 6-31, 40-48, 52-57, 61-86, 95-103, 107-112, 116-141, 150-158, and 162-168 as unpatentable over Narasimhan in view of Cotteret

The Examiner found that Narasimhan teaches the invention as claimed with the exception of the cationic homopolymer comprising the repeating units of the claimed formula (I). (Answer 3). However, the Examiner notes that Narasimhan generally teaches the use of cationic homopolymers or copolymers derived from acrylic methacrylic acid wherein the monomer units are selected from the group consisting of acrylamide, methylacrylamide, diacetone-acrylamide, acrylamide or methacrylamide substituted on the nitrogen by lower alkyl, alky ester of acrylic acid and methacrylic acid. (Answer 4). The Examiner maintains that it would have been obvious to one of ordinary skill in the art to use a cationic homopolymer having formula (I) in Narasimhan's composition in view of Cotteret's disclosure of a hair dyeing composition comprising a cationic polymer of polyquaternium 37 (i.e., a species within Narasimhan's disclosed genus of cationic homopolymers). According to the Examiner, one of ordinary skill in the art would have been motivated to combine the teachings of Narasimhan and Cotteret for the following reasons:

[T]he primary reference of Narasimhan et al, suggests the use of cationic polymers in the dyeing composition as conditioning agents (see col.14, line 34) and the secondary reference of Cotteret et al. (US' 908), clearly teaches the polymer of polyquaternium 37 which is structurally similar to those claimed, and, thus, a person of an ordinary skill in the art would be motivated to use the polymer of polyquaternium 37 in the composition of Narasimhan (US' 989 B1) with a reasonable

expectation of achieving successful composition for dyeing hair, and would expect such a composition to have similar properties to those claimed, absent unexpected results. Further, the similarities in chemical structure between the prior art and the claimed compounds and which have similar utilities establishes a *prima facie* case of obviousness. (Answer 5).

[O]ne having ordinary skill in the art would have found it *prima facie* obvious to add the cationic polymers (polyquaternium-37) discussed in Cotteret et al. (US' 908) into the composition of Narasimhan et al. (US' 989 B1) with the reasonable expectation of obtaining all of the advantages discussed in Cotteret. (Answer 9).

Appellants argue that the Examiner has oversimplified the steps required to arrive at the claimed invention from the combined teachings of Narasimhan and Cotteret and has failed to establish the requisite motivation to combine these references. Specifically, Appellants argue the Examiner has not provided reasons for his selection of the claimed components from Narasimhan's extensive list of both required and optional composition components. In addition, Appellants assert that even assuming one of ordinary skill in the art would have selected the claimed fatty alcohol, alkoxylated fatty alcohol, fatty amide, and oxidizing agent, the Examiner has not explained why one of ordinary skill in the art would have selected polyquaternium 37 from Cotteret's extensive list of cationic polymers, particularly give Cotteret's preference for cationic polymers which are not homopolymers comprising repeating units of formula (I).

Where all the elements of an invention can be found in a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have suggested

to one of ordinary skill in the art that he should make the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have revealed that in so making or carrying out, one of ordinary skill would have a reasonable expectation of success.

In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Both the suggestion and the reasonable expectation of success “must be founded in the prior art, not in the applicant's disclosure.” *Id.* In this case, the Examiner has explained why one of ordinary skill would have reasonable expectation of success (factor (2)), but has failed to provide a *detailed* analysis of the prior art and reasons why one of ordinary skill in the art would have possessed the knowledge and motivation to make the combination recited in the claims (factor (1)). When the Examiner does not explain the motivation, suggestion or teaching that would have led the skilled artisan to the claimed combination, there is an inference that the Examiner relied on hindsight to conclude that the invention was obvious.

See In re Kahn, 441 F.3d 977, 986, 78 USPQ2d 1329, 1337 (Fed. Cir. 2006).

We are in agreement with Appellants that, in this case, a *prima facie* showing of obviousness based on the applied prior art required, at a minimum, some explanation as to why one of ordinary skill in the art would have selected polyquaternium 37 from Cotteret's extensive list of cationic polymers. The Examiner has not directed us to any objective teaching in the prior art or identified the information generally available to one of ordinary skill in the art which would have led that individual to select polyquaternium 37, or any other cationic homopolymer having the claimed formula (I), for use in Narasimhan's composition. *See In re Fine*, 837 F.2d 1071, 1075, 5 USPQ

1596, 1598 (Fed. Cir. 1988).¹ At best, the Examiner's reasons for combining the teachings of Narasimhan and Cotteret establish a "general incentive" to make the proposed combination. While a "general incentive" may make an approach "obvious to try" it does not make the invention obvious. *In re Deuel*, 51 F.3d 1552, 1559, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995). See *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988) ("Obvious to try" is not the standard of obviousness under 35 U.S.C. § 103.).

The rejection is reversed.

Rejection of claims 32-39, 49-51, 87-94, 104-106, 142-149, and 159-161 as unpatentable over Narasimhan in view of Cotteret and further in view of Casperson

¹ See also, *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337, 75 USPQ2d 1051, 1054 (Fed.Cir.2005)(citations omitted):

[I]n making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention as a whole." Inventions typically are new combinations of existing principles or features. The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. Id. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result-often the essence of invention.

The examiner relies on the combined teachings of Narasimhan and Cotteret as discussed in connection with the rejection of independent claims 1, 57, 110, and 166, citing Casperson for a showing of features recited in dependent claims 32-39, 49-51, 87-94, 104-106, 142-149, and 159-161. Accordingly, we reverse the Examiner's rejection for the same reasons stated above.

REVERSED

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